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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,606	07/25/2005	Helena Lindskog	P17223-US1	2617

27045 7590 02/19/2008

ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO, TX 75024

EXAMINER	
HOANG, SON T	
ART UNIT	**PAPER NUMBER**
2165	

MAIL DATE	DELIVERY MODE
02/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/519,606	LINDSKOG ET AL.	
	Examiner	Art Unit	
	Son T. Hoang	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *15 January 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 December 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 15, 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to **claims 24-47** have been considered but are deemed to be not persuasive. After further search and a thorough examination of the present application, **claims 25-47** remain rejected

Applicant's argument towards **independent claims 25**, **33**, **37**, and **44** with reference to Cranor et al. (*Platform for Privacy Preferences Syntax Specification*, hereinafter Cranor) regarding the fact that Cranor does not disclose "*a cookie-policy receipt based only on a user decision*" as amended.

The Examiner respectfully submits in particular in response to the Applicant's argument. Evidently, Applicant defines "*a user decision*" to consist of two types, i.e. one is generated directly from the user's input, and one is generated indirectly through a comparison between the privacy policy and user references ([Specification, Page 16, Lines 2-5]).

Accordingly, Cranor discloses the user agent sends out the requested data to the content provider after the receipt of a proposal received from said content provider. In addition, the user agent MUST include the *agreementID(s)* it believes it is operating under to the content provider ([*Section 3.3.4, Page 16*]). Cranor defines the *agreementID(s)* as a record of the agreement reached by the user agent and the content provider regarding if the privacy practices of the content provider matches the user's preferences or not ([*Section 1.3, Pages 4-5*]). This citation clearly anticipates the limitation of "*cookie-policy receipt based only on a user decision*" as amended by the Applicant.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 44-47** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding **claim 44**, "*a content provider apparatus adapted for...*" is being recited with multiple components, e.g. means for receiving a resource request, means for transmitting a privacy policy, means for receiving a cookie-policy receipt, means for providing cookie. However, Applicant clearly states in the specification that "*the means of the content provider 200 in Figure 6, i.e. I/O unit 210, cookie generator 230, and database processor 240 can be implemented in software*" ([Page 25, Lines 11-14]), thus confirms that these components are

indeed software components. Therefore, the claimed apparatus is directed to a software apparatus itself not a process occurring as a result of actually executing the software components, a machine programmed to operate in accordance with the software components, nor a manufacture structurally and functionally interconnected with the software components in a manner which enables the software components to carry out their functionalities. The claimed system is also not a combination of chemical compounds to be a composition of matter. As such, it fails to fall within a statutory category. It is, at best, functional descriptive material *per se*.

Claims 45-47 fail to resolve the deficiencies of **claim 44** since they only further limit the scope of **claim 44**. Hence, **claims 45-47** are also rejected under 35 U.S.C. 101.

The claims above lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded

on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.")

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate Paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this Section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 25-30**, **33-42** and **44-47**, are rejected under 35 U.S.C. 102(b) as being anticipated by Cranor et al. (*Platform for Privacy Preferences Syntax Specification*, hereinafter Cranor).

Regarding **claim 25**, Cranor clearly shows and discloses a method of managing cookies in a data processing system ([Pages 4-5, Section 1.3]) comprising the steps of:

a user agent requesting a resource associated with a cookie (proposal) from a content provider (*home page of CoolCatalog*, [Page 45, Appendix 4]).

receiving a privacy policy associated with said cookie; and (*CoolCatalog sends a proposal, including privacy practices, disclosures, and the data elements to which they apply*, [Page 45, Appendix 4]).

said user agent transmitting, in response to reception of said privacy policy associated with said cookie (*receipt of a proposal*, [Page 16, Section 3.3.4, Paragraph 1]), a cookie-policy receipt to said content provider, said cookie-policy receipt based only on a user decision, said user decision specifying whether a user associated with said user agent accepts that said content provider provides said cookie to user equipment associated with said user agent (*agreementID / fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4]).

Regarding **claim 26**, Cranor further discloses a method wherein user agent transmitting said cookie-policy receipt (*agreementID/fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4] in a resource fetch message (*OK in case of acceptance*, [Page 14, Section 3.3.1] *or SRY in case of refusal* [Page 15, Section 3.3.3, Paragraph 1]).

Regarding **claim 27**, Cranor further discloses said user decision is determined by:

said user agent comparing said privacy policy with user preference, said user preference specifying a cookie privacy policy accepted by said user (*to determine whether to enter into an agreement. An agreement applies to all data exchanged between the user agent and service within a specified realm* [Page 5, Section 1.3, Paragraph 2]); and

said user agent generating said cookie-policy receipt based on said comparison (*agreementID/fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4]).

Regarding **claim 28**, Cranor further discloses a method wherein if said received privacy policy does not match said user preference ([Page 5, Section 1.3, Paragraph 4]), said method further comprising the steps of:

said user agent presenting said received privacy policy for said user on said user equipment (*shown to a human user*); and

said user agent generating said cookie-policy receipt in response to a user-input signal (*agreementID / fingerprint of agreement*).

Regarding **claim 29**, Cranor further discloses wherein said user decision is determined by:

said user agent presenting said received privacy policy for said user on said user equipment (*shown to a human user*); and

said user agent generating said cookie-policy receipt in response to a user-input signal (*agreementID / fingerprint of agreement*)

Regarding **claim 30**, Cranor further discloses the step of authenticating said cookie-policy receipt with an authentication key associated with said user agent (*The MD5 algorithm is intended for digital signature applications, where a large file must be "compressed" in a secure manner before being encrypted with a private (secret) key under a public-key cryptosystem such as RSA or PGP*, [Pages 41-44, Appendix 2]).

Regarding **claim 33**, Cranor clearly shows and discloses a method of providing cookies in a data processing system where in a user agent requests a resource associated with a cookie from a content provider ([Pages 4-5, Section 1.3]), said method comprising the steps of:

receiving a resource request, wherein the resource is associated with a cookie from said content provider ([Page 45, Appendix 4, Paragraph 2]),

transmitting a privacy policy associated with said cookie to said user agent ([Page 45, Appendix 4, Paragraph 4]);

receiving a cookie-policy receipt based only on a user decision from said user agent (*CoolCatalog sends a proposal, including privacy practices, disclosures, and the data elements to which they apply*, [Page 45, Appendix 4]);

said content provider providing, in response to reception of a cookie-policy receipt from said user agent (*user agent sending out requested data including agreementID it is operating under to server*, [Page 16, Section 3.3.4, Paragraph 1]), said cookie to user equipment associated with said user agent if said cookie-policy receipt specifies that a user associated with said user agent accepts that said content provider provides said cookie to said user equipment (*once the user has accepted the agreement, the service will send the appropriate data elements, which are then saved transparently by the user agent*, [Pages 10-11, Section 2, Scenario 5]).

Regarding **claim 34**, Cranor further discloses a method wherein user agent transmitting said cookie-policy receipt in a resource fetch message (*OK in case of acceptance*, [Page 14, Section 3.3.1] *or SRY in case of refusal* [Page 16, Section 3.3.3, Paragraph 1]).

Regarding **claim 35**, Cranor further discloses a method wherein, said cookie-policy receipt specifies that a user associated with said user agent accepts that said content provider provides said cookie to said user equipment (*once the user has accepted the agreement, the service will send the appropriate data elements, which are then saved transparently by the user agent*, [Pages 10-11, Section 2, Scenario 5]).

Regarding **claim 36**, Cranor further discloses a method wherein cookie policy receipt is generated based on a comparison between said privacy policy

and user preference ([Page 5, Section 1.3, Paragraphs 3-4]) that specifies a cookie privacy policy accepted by said user (*An agreement applies to all data exchanged between the user agent and service within a specified realm* [Page 5, Section 1.3, Paragraph 2]).

Regarding **claim 37**, Cranor clearly shows and discloses a data processing system for requesting a resource associated with a cookie (data) from a content provider ([Pages 4-5, Section 1.3]), said data processing system comprising:

a user agent ([Page 13, Section 3.2, Paragraph 1]), said user agent comprising:

means for receiving a privacy policy associated with said cookie; ([Page 13, Section 3.2]) and

means for transmitting (*communicating to the server using standard HTTP methods such as "GET" or "POST"*, [Page 13, Section 3.2, Paragraph 1]), in response to reception of a privacy policy associated with said cookie (*receipt of a proposal*, [Page 16, Section 3.3.4, Paragraph 1]), a cookie-policy receipt (*agreementID/fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4]) to said content provider, said cookie-policy receipt based only on a user decision, said user decision specifying whether a user associated with said user agent accepts that said

content provider provides said cookie to user equipment associated with said user agent ([Page 5, Section 1.3, Paragraph 4]).

Regarding **claim 38**, Cranor further discloses that transmitting means (*standard HTTP methods such as "GET" or "POST"*, [Page 13, Section 3.2, Paragraph 1]) from user agent to content provider includes said cookie-policy receipt in a resource fetch message (*OK in case of acceptance*, [Page 14, Section 3.3.1] *or SRY in case of refusal* [Page 15, Section 3.3.3, Paragraph 1]).

Regarding **claim 39**, Cranor further discloses a data processing system according comprising means for determining the user decision, said means for determining further comprising:

means for comparing said received privacy policy with user preference to determine whether to enter into an agreement (*An agreement applies to all data exchanged between the user agent and service within a specified realm*, [Page 5, Section 1.3, Paragraph 2]).

means for generating, connected to said comparing means, said cookie-policy receipt as a function of said comparing of said privacy policy with said user preference ([Page 5, Section 1.3, Paragraphs 3-4]).

Regarding **claim 40**, Cranor further discloses [Page 5, Section 1.3, Paragraph 4] a means for presenting said received privacy policy (proposal) for said user on said user equipment (*shown to a human user*), said generating

means being adapted for generating said cookie-policy receipt (*agreementID/fingerprint of agreement*) in response to a user input signal.

Regarding **claim 41**, Cranor further discloses means for determining the user decision, said means for determining further comprising:

means for presenting said received privacy policy for said user on said user equipment (*shown to a human user*, [Page 5, Section 1.3, Paragraph 4]); and

means for generating said cookie-policy receipt in response to a user input signal (*agreementID / fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4]).

Regarding **claim 42**, Cranor further discloses a means to authenticate said cookie-policy receipt (*agreementID / fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4]) with an authentication key associated with said user agent (*The MD5 algorithm is intended for digital signature applications, where a large file must be "compressed" in a secure manner before being encrypted with a private (secret) key under a public-key cryptosystem such as RSA or PGP*, [Page 41, Appendix 2]).

Regarding **claim 44**, Cranor clearly shows and discloses a content provider apparatus adapted for providing a requested resource associated with a cookie to a user agent in a data processing system ([Pages 4-5, Section 1.3]), said content provider comprising:

means to receiving a resource request from said user agent ([Page 9, Section 2, Scenario 1, Protocol Scenario]);

means for transmitting a privacy policy associated with said cookie to said user agent (*content/proposal is sent to user agent in a header, HTML header, or as referenced by URL*, [Page 9, Section 2, Scenario 1, Protocol Scenario]); means for receiving a cookie-policy receipt based only on a user decision [Page 9, Section 2, Scenario 1, Protocol Scenario]; and

means for providing, in response to reception of a cookie-policy receipt (*agreementID/fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4] from said user agent (*user agent sending out requested data including agreementID it is operating under to server*, [Page 16, Section 3.3.4, Paragraph 1], said cookie to said user equipment associated with said user agent if said cookie-policy receipt (*agreementID/fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4]) specifies that a use associated with said user agent accepts that said content provider provides said cookie to said user equipment (*once the user has accepted the agreement, the service will send the appropriate data elements, which are then saved transparently by the user agent*, [Pages 10-11, Section 2, Scenario 5]).

Regarding **claim 45**, Cranor further discloses that a content provider apparatus receiving said cookie-policy receipt (*agreementID/fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4] in a resource fetch message (*OK in case of acceptance*, [Page 14, Section 3.3.1] *or SRY in case of refusal* [Page 15, Section 3.3.3, Paragraph 1]).

Regarding **claim 46**, Cranor further discloses means for providing said cookie-associated resource (*content/proposal is sent to user agent in a header, HTML header, or as referenced by URL*, [Page 9, Section 2, Scenario 1, Protocol Scenario]) if said cookie-policy receipt specifies that said user accepts that said content provider provides said cookie to said user equipment (*once the user has accepted the agreement, the service will send the appropriate data elements, which are then saved transparently by the user agent*, [Pages 10-11, Section 2, Scenario 5]).

Regarding **claim 47,** Cranor further discloses a content provider apparatus wherein cookie policy receipt (*agreementID / fingerprint of agreement*, [Page 5, Section 1.3, Paragraph 4]) is generated based on a comparison between said received privacy policy and user preference ([Page 5, Section 1.3, Paragraphs 3-4]) that specifies a cookie privacy policy accepted by said user (*An agreement applies to all data exchanged between the user agent and service within a specified realm* [Page 5, Section 1.3, Paragraph 2]).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 31-32** and **43**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Cranor in view of Mitchell et al. (Pat. No. US 6,959,420, filed on November 30, 2001; hereinafter Mitchell).

Regarding **claim 31**, Cranor does not specifically disclose the step of removing previously stored cookie(s) associated with requested resource in user equipment.

Mitchell discloses a method to evaluate web site platform for privacy preferences policy wherein operation for web site to persist, retrieve (referred to as replay) or delete its cookie data in the set of cookies on the user's machine being done through user input via a prompt ((Column 7, Line 56 → Column 8, Line 28]).

It would have been obvious to a person with ordinary skills in the art at the time the invention was made to incorporate the teachings of Mitchell with the teachings of Cranor for the purpose of evaluating privacy policies provided by web sites to determine whether each side is permitted to perform operations (e.g., store, retrieve or delete) directed to cookies on a user's computer by comparing the privacy policy specified by the web site to the user's privacy

preferences and other specified information available on the client computer ([Column 2, Lines 34-43] of Mitchell).

Regarding **claim 32**, Mitchell further discloses ignoring a cookie request command transmitted from said content provider to said user agent if said cookie-policy receipt specifies that said user does not accept that said content provider provides said cookie to said user equipment (*evaluating web site platform for privacy preferences policy wherein user's response to the prompt may be stored in association with a particular web site so that the user needs not again to be interrupted when this site is accessed*, [Column 12, Lines 39-53]).

Regarding **claim 43**, Mitchell further discloses removing a cookie associated with said requested resource from a storage in said user equipment if said cookie-policy receipt specifies that said user does not accept that said content provider provides said cookie to said user equipment (*evaluation of web site platform with user's privacy preferences policy wherein there is a means for user agent to delete its cookie data in the set of cookies on the user's machine being done through user input via a prompt*, [Column 7, Line 56 → Column 8, Line 28]).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gordon et al. (Patent No. US 7,137,009 B1)teaches a method for securing a cookie cache in a data processing system.

Schran et al. (Pub. No. US 2002/0143770 A1) teaches a method for network administration and local administration of privacy protection criteria.

Cranor et al., *"The Platform for Privacy/ Preferences 1.0 (P3P 1.0) Specification"* teaches the implementation of interoperable P3P applications.

The Examiner requests, in response to this Office action, support(s) must be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the Examiner in prosecuting the application.

When responding to this office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Contact Information

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Son T. Hoang whose telephone number is (571) 270-1752. The Examiner can normally be reached on Monday - Friday (7:30 AM – 5:00 PM).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Christian Chace can be reached on (571) 272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHRISTIAN CHACE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

/S.H./
Son T. Hoang
Patent Examiner
Art Unit 2165
February 11, 2008